

**REMARKS**

By way of this response, Applicants have amended claims 1, 5, 6, 9 and 17 and canceled claims 35-37 without prejudice or disclaimer. In view of the above amendments and the following remarks, reconsideration of the outstanding office action is respectfully requested.

The Office has rejected claims 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, 24-25, 31-33 and 39-47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,778,982 to Knight et al. (Knight) in view of U.S. Pat. Pub. 2002/0032735 to Burnstein et al. (Burnstein), and claims 35-38 stand rejected under 35 U.S.C. § 103(a) as being obvious over Knight in view of Burnstein and further in view of U.S. Pat. Pub. 2002/0059164 to Shtivelman (Shtivelman). These rejections are respectfully traversed at least for the reasons provided below.

In the Office Action, the Office asserts that “Knight et al. teaches an online content provider system and method for compiling, creating and presenting content to users. Furthermore, Knight et al. teaches an information monitoring device that monitors one or more electronic documents in an information stream associated with a first electronic forum, and compares information about one or more electronic email documents to one or more rules (See col. 9, lines 43-50 and col. 22, lines 35-44), Remark: Knight teaches first kind of extraction robot of the present invention periodically retrieve content from outside sources and online message board system. The content is extracted from these sources according to set of rules, filters or criteria specified by the online provider, and/or gleaned from community based traffic monitoring); However, Knight et al. fails to teach forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users and a subscriber determining device that determines which of the queried users indicate interest in the new electronic forum and subscribes each interested user to the new electronic forum, but does not subscribe users of the set who do not indicate interest in the new electronic forum.”

Knight teaches a first kind of extraction robot that periodically retrieve content from outside sources and online message boards and then extracts content from these sources according to set of rules, filters or criteria specified by the online provider, and/or gleaned

from community based traffic monitoring. The Office acknowledges that Knight fails to teach a forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users, but asserts Burnstein teaches an automatic telephone, internet or intranet community formation that contacts currently searching and the previously searching users and asks them if they want to join a new community on the topic of the search string in the following manner. The Office asserts in Burnstein that the user currently searching is contacted automatically and if that user indicates their interest in joining a community then the second action is to locate non-searching user(s) in the matched field and contacted them and ask if they want to join this community. The Office asserts that in Burnstein if each answers in the affirmative, a new community is formed automatically and the users are entered as members of that community (See page 8, paragraph [0098] and [0100] to [0101]). Furthermore, the Office asserts that Burnstein teaches wherein the input can be E-mail (See page 8, paragraph [0101]). The Office asserts it would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein in the system disclosed in Knight in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (see page 1, paragraph [0013]).

However, Knight, Burnstein and Shtivelman, taken alone or in combination, do not suggest or disclose the features of “a forum spawning device adapted to query a set of users participating in the first forum when at least **two** of the **two** or more rules is satisfied, and creates a new electronic forum based on one or more replies from the set of users; and a subscriber determining device adapted to determine which of the queried users indicate interest in the new electronic forum and subscribes each interested user to the new electronic forum, but does not subscribe users of the set who do not indicate interest in the new electronic forum, wherein the **two** or more rules comprise at least **two** of the following: how long the electronic forum has been in use; how many email messages have been exchanged on the electronic forum; whether there has been a suggestion to create a new discussion forum; whether a certain number of email messages on a particular topic been received within a predetermined time period; whether the rate of email messages exchanged on a particular topic been statistically greater than normal; or whether a certain number of forum members

exchanged email messages on a particular topic within a predetermined time period,” as recited in amended independent claim 1, “comparing information about the one or more email documents to **two** or more rules; querying a set of users participating in the first electronic forum when at least **two** of the **two** or more rules is satisfied; creating a new electronic forum automatically based on one or more replies from the set of users, and subscribing each queried user of the set indicating interest in the new electronic forum to the new electronic forum, but not subscribing to the new electronic forum users of the set who do not indicate interest, wherein the **two** or more rules comprise at least **two** of the following: how long the electronic forum has been in use; how many email messages have been exchanged on the electronic forum; whether there has been a suggestion to create a new discussion forum; whether a certain number of email messages on a particular topic been received within a predetermined time period; whether the rate of email messages exchanged on a particular topic been statistically greater than normal; or whether a certain number of forum members exchanged email messages on a particular topic within a predetermined time period,” as recited in amended independent claims 9 and 17.

As disclosed on page 4, lines 3-24 in the above-identified patent application, the present invention monitors an information stream associated with a first electronic forum with an information monitoring device. A set of users participate in the first electronic forum for example, by sending or receiving electronic email documents over the information stream. Information about one or more of these documents is compared to two or more rules. If two of the rules are satisfied, a set of users who are participating in the first electronic forum are queried by the forum spawning device. Responsive to the replies from the queried users, the forum spawning device may create a new electronic forum. Thus, by way of example only, if members of a newsgroup started to post messages related to a topic that was determined (by the rules) not to be within the topic of the newsgroup, the invention would query users of the newsgroup whether a new newsgroup should be created. Responsive to the replies to the queries, the invention could generate a new newsgroup with the new topic.

As set forth at col. 5, line 63 to col. 27, Knight teaches a bulletin board system that searches for and classifies content in order to provide a more useful interface to a user of an online message board to assist the user in finding his/her desired information by information categories or via a user query. Knight simply addresses the problem of finding desired information on an online message board where the messages are incorrectly classified

in existing forums (for example, where messages have been sent to the wrong discussion group). Knight does this by classifying the content in user submitted documents (postings), as described at col. 8, lines 48-54 and at col. 8, line 66 to col. 9, line 2, as well as user queries and allowing the user to search on the classified content instead of forcing the user to be constrained by a forum. Knight classifies information posted by users as well as information found by bots from internal and external sources. Knight does not teach or even suggest a need to spawn a new electronic forum because the purpose of Knight is to find desired information in a forum-independent manner based on the content of the available information, as disclosed at col. 14, line 56 to col. 15, line 14.

As disclosed in paragraphs [0013], [0018], [0020], [0023], [0036], [0037], [0067] to [0069], [0078], [0082], [0085], [0087], [0089], [0100], [0101], [0137] and [0138], Burnstein teaches tracking search strings, matching those who have used similar search strings (already created by users instead of newly created), and proposing to those who have used similar search strings that they form a community (basically a news group). Burnstein assumes those who have made similar searches will have a common interest. Accordingly, Burnstein teaches matching users by the search strings they have provided by users, not by monitoring available documents in an information stream and then creating a new electronic forum, as presently claimed. Nothing in Burnstein suggests monitoring documents in a first electronic forum or creating a new electronic forum based on one or more replies from users. Additionally, Burnstein does not teach querying a set of users who are participating in the first forum, but instead Burnstein teaches querying users who have provided similar search strings from at least two different forums (searching users and non-searching users). Further, Burnstein teaches creating a “new community” only if the “current searching user” (who is automatically contacted) indicates an interest in joining the “new community,” only then will the second action occur of contacting the “non-searching user,” otherwise no “new community” will be created or action performed (see paragraphs [0067] to [0069] of Burnstein). The “if-then-else” configuration of Burnstein is contrary to the principles and configuration of the present invention as discussed above. Applicants also contend that it is unclear where Burnstein teaches or suggests the limitations of “does not subscribe users of the set who do not indicate interest in the new electronic forum” or “not subscribing to the new electronic forum users of the set who do not indicate interest,” as claimed. In contrast, Burnstein clearly states “[I]f each (user) answers in the affirmative, then invention

automatically forms a new community and the users are entered as members of that community” (see page 8, paragraph [0098] of Burnstein) [emphasis-added]. That is, it appears that Burnstein requires each user (initially current searching users then non-searching users only if the current searching users affirm the query) to answer in the affirmative before creating any new community, otherwise no action is taken. Thus, Burnstein does not have the capability to exclude users who show no interest in joining the new community; instead Burnstein is configured to initiate a new community only if current searching users affirm before it can perform any second action to query non-searching users that may have an interest. The present invention does not have any such limitation as taught in Burnstein.

Thus, even if Knight is considered in view of Burnstein, as suggested by the Office, it would not teach the claimed combinations. Further, the Office has not established any motivation for why one of ordinary skill in the art would be motivated to combine an online content system for creating, compiling and presenting content to subscribers which includes the use of search bots as disclosed in Knight with an automatic telephone, Internet or intranet community formation system that matches users based upon entered search strings, as disclosed in Burnstein other than by using impermissible hindsight after viewing the present invention. Like Knight and Burnstein, the other reference of Shtivelman cited by the Office, alone or in combination, does not teach or suggest the claimed combination.

In view of the foregoing amendments and remarks, the Office is respectfully requested to reconsider and withdraw the rejection of independent claims 1, 9 and 17. Since claims 3, 5, 6, 8, 31 and 39-41 depend from and contain the limitations of claim 1, claims 11, 13, 14, 16, 32 and 42-44 depend from and contain the limitations of claim 9, and claims 19, 21, 22, 24, 25, 33 and 45-47 depend from and contain the limitations of claim 17, they are distinguishable over the cited references and are patentable in the same manner as independent claims 1, 9 and 17.

In view of all of the foregoing, Applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

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